

REMARKS

The Office Action dated October 16, 2006, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-19, 21-40, and 42-52 are currently pending in the application, of which claims 1, 19, 32, 40, and 51-52 are independent claims. Claims 1-19, 21-40, and 42-52 are respectfully submitted for consideration in light of the following remarks.

Claims 1-19 and 21-31 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Office Action took the position that the claims define non-statutory subject matter, specifically an abstract idea. Applicants respectfully traverse this rejection.

The claim recitations “communicating information” and “using the determined type of classification to control the communicating information” (recited, for example, in claim 1) define more than just an abstract idea. Furthermore, “communicating information” ties the claimed method to the technological art of communications. Furthermore, “control of the communicating” is a concrete and useful result that is recited in the claim, although there is no statutory requirement that the utility be recited in the claim.

Claim 19 has its own scope but similarly recites “based upon the classifying ... forming a compressed list” and “transmitting said compressed list.” Thus, it is respectfully submitted that claim 19 also recites statutory subject matter.

Claims 2-18 and 21-31 depend respectively from claims 1 and 19, and thus similarly recite statutory subject matter. Thus, for at least these reasons, it is respectfully requested that the rejection of claims 1-19 and 21-31 be withdrawn.

Claims 1-2, 14-15, 19, 21, 27-28, and 33-52 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,864,860 of Holmes (“Holmes”) in view of U.S. Patent No. 7,061,936 of Yoshimura et al. (“Yoshimura”). The Office Action took the position that Holmes teaches many of the elements of the claims, and cited Yoshimura to remedy certain deficiencies of Holmes. Applicants respectfully traverse this rejection.

Yoshimura is not proper prior art to the present application. Yoshimura issued June 13, 2006, based on an application filed February 26, 2001. The present application was filed January 9, 2001, and claims priority to a provisional application (Application No. 60/211,986) filed June 16, 2000. Thus, the present application antedates Yoshimura, because the present application was filed before Yoshimura.

Yoshimura was based on a Japanese application filed March 3, 2000, but the Japanese filing date of Yoshimura is inconsequential to its prior art status under U.S. law. Because Yoshimura was published after the filing date of the present application, the only arguable basis upon which it could be considered prior art would be 35 U.S.C. 102(e).

The USPTO’s interpretation of 35 U.S.C. 102(e), however, is that the effective date of such a reference is its earliest U.S. filing date with some exceptions for certain

international applications that designate the U.S. and are published in English (the exceptions do not apply to the present rejection).

Thus, Applicants respectfully submit that Yoshimura cannot be considered prior art, because its earliest effective filing date is later than the filing date of the present application. The rejection cannot stand without Yoshimura. It is, therefore, respectfully requested that the rejection based on Yoshimura be withdrawn.

Claims 1-2, 14-15, 19, 21, 27-28, and 33-52 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,864,860 of Holmes ("Holmes") in view of U.S. Patent No. 6,882,637 of Le et al. ("Le"). The Office Action took the position that Holmes teaches many of the elements of the claims, and cited Le to remedy certain deficiencies of Holmes. Applicants respectfully traverse this rejection.

Le is barred from being used to show obviousness of the claims of the present application under 35 U.S.C. 103(c), because it was subject to an obligation of assignment to the same entity as the present application at the time of the invention, and because it was issued after the present application was filed.

Le issued April 19, 2005, on an application filed March 28, 2000, which claimed priority to a provisional application filed October 14, 1999. The present application, as explained above, has an effective filing date of June 16, 2000. Accordingly, Le is only available as prior art (if at all) under 35 U.S.C. 102(e).

Furthermore, Le was subject to an obligation of assignment to the same entity, Nokia Networks Oy (an entity of Nokia Corporation), as the present application at the

time of the invention. Evidence of this mutual obligation of assignment is seen in Le's assignment to Nokia Networks Oy, Keilalahdentie 4, 02150 Espoo, Finland, on July 25, 2000, at Reel 010954, Frame 0797. It is also seen in the assignment of the present application to Nokia Networks Oy, Keilalahdentie 4, 02150 Espoo, Finland, on April 13, 2001, at Reel 011689, Frame 0834. It is further evidenced by the fact that the three presently named inventors of the present application are three of the four named inventors of Le.

Accordingly, Le is barred by 35 U.S.C. 103(c) from being used to show obviousness of the claims of the present application because it was issued after the present application was filed and was subject to an obligation of assignment to the same entity, Nokia Networks Oy, at the time of the invention. Thus, it is respectfully requested that the rejection based on showing obviousness using Le be withdrawn.


Claims 5-13 and 25-29 were again rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes and Yoshimura in view of U.S. Patent No. 6,535,925 of Svanbro et al. ("Svanbro"). The Office Action took the position that Holmes and Yoshimura teach most of the elements of the claims, except for some elements related to encoding the information. The Office Action cited Svanbro to remedy the deficiencies of Holmes and Yoshimura. As noted above, Yoshimura is not proper prior art, and the rejection cannot stand without Yoshimura. Accordingly, Applicants respectfully traverse this rejection and request that the rejection be withdrawn.

For the reasons explained above, it is respectfully submitted that each of claims 1-19, 21-40, and 42-52 recites statutory subject matter that is neither disclosed nor suggested in the prior art. It is, therefore, respectfully requested that all of claims 1-19, 21-40, and 42-52 be allowed, and this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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